

### REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 23-37 remain pending in the present application. Claims 23, 27, 30 and 34 have been amended to address cosmetic matters of form. No new matter has been added.

By way of summary, the Official Action presents the following issues: Claims 23 and 24 stand rejected under 35 U.S.C. §112, second paragraph; and Claims 23-37 stand rejected under 35 U.S.C. §102 as being unpatentable over Downs et al. (U.S. Patent No. 6,226,618, hereinafter Downs).

### FINAL ACTION IS PREMATURE

Concurrent with the petition under 37 C.F.R. § 1.181 submitted herewith and seeking withdrawal of the outstanding Final Rejection as premature,<sup>1</sup> Applicants provide the following discussion for facilitating supervisory review of the finality of the Official Action dated March 18, 2008 in accordance with MPEP § 706.07 (d).

In rejecting pending Claims 24-35, the Office noted that page 4 of the Official Action dated March 18, 2008 that:

Claims 24-35 recite the functional language whereby. These claims have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. Thus, Claims 24-35 are rejected on the same rational as Claim 23 above.

In support of the above position, the Office has cited *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983):

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<sup>1</sup> See MPEP § 706.07 (c).

It appears as though the Office is taking the position that the mere existence of the word “whereby” is grounds for ignoring the entirety of the claim; Of course *In re Gulack* stands for no such proposition.

The Office explains that the claims have been considered but the language of the claims have been given little patentable weight and, in fact, have been regarded as “intended use language.” In this regard, Applicants direct the Office’s attention to Claim 25 in which the system is recited as further comprising a remote payment server. It is unclear if what, if anything, this further system component has to do with “intended use.”

By way of further example, Claim 26 recites a further system component “secure means.” This further system component clearly has nothing at all to do with “intended use”.

Additional claims of Claims 24-35 recite various aspects and functionalities of the system as claimed. The mere occurrence of the terminology “whereby” in the claims certainly does not excuse the Office from examining these claims.

In this regard, CFR 1.104(c)(2) which states: "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, **must be clearly explained and each rejected claim specified.**"

Furthermore, the MPEP states:

“In order to provide a complete application file history and to enhance the clarity of the prosecution history record, **an examiner must provide** clear explanations of all actions taken by the examiner during prosecution of an application” (See MPEP § 707.07(f) (emphasis added)).

Due to the complete lack of any clear explanation or identification of a particular aspect relied upon in the recited references relative to claims 24-35, Applicants are at a loss

to properly rebut the current final action. The Official Action has not cited any aspect of the Downs reference (the only reference currently utilized in rejecting the claims of record) in rejecting claims 24-35. Indeed, it does not appear as though Claims 24-35 have been examined. Therefore, the grounds of the rejection have not been clearly developed to such an extent that the Applicants can readily judge the advisability of an appeal. Accordingly, Applicants respectfully submit that the finality of the Official Action dated March 18, 2008 is premature and should be withdrawn.

The following response will address the rejection in the present form despite the complete lack of clarity and/or identification of any art relative to Claims 24-35.

#### REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Official Action has rejected Claim 23 under 35 U.S.C. §112, second paragraph, as indefinite. Applicants respectfully traverse the rejection.

The Official Action, at page 2, identifies the terminology “communicatively” and “operably” as allegedly relative terms. Applicants respectfully submit that the above-noted terminology is not relative terminology, in fact, it is quite clear in scope. “Communicatively linked” simply requires a linking to enable communication, such as a direct wired connection, or a wireless connection. As this broader claim terminology embraces both types of communication linking, it is preferred.

Additionally, the term “operably” requires a linkage which enables cooperation between elements. This terminology is very well known in the art, and the Office is respectfully invited to perform a search for these claim terms in issued patents. As of the filing date of this response, over forty-thousand patents include the above-noted terminology as features of the claims. Additionally, well over five-thousand patents include the term “communicatively” in their issued claims to describe communication linking as explained

above. As such, Applicants respectfully submit that as this claim terminology is well known in the art for describing a linkage for operation and/or communication purposes, that Claim 23 is definite as written.

Accordingly, Applicants respectfully request that the rejection of Claim 23 under 35 U.S.C. §112, second paragraph be withdrawn.

#### REJECTIONS UNDER 35 U.S.C. §102

The Official Action has rejected Claims 23-37 under 35 U.S.C. §102.<sup>2</sup> The Official Action contends that Downs describes all of the Applicants claimed features. Applicants respectfully traverse the rejection.

Applicants Claim 23 recites, *inter alia*, a payment system for controlling the continued use of a software program by a user, including:

a terminal configured to access software from a computer readable storage communicatively linked thereto, **the software providing an interface** offering **continued utilization** of the software in exchange for payment from the user, the interface providing at least an identity of **the software** owner, offer parameters and the digital signature of the owner for at least part of the offer, and configured to generate a first message; . . . (emphasis added)

Downs describes an electronic content delivery system in which a digital content store provides an encrypted version of digital content to a user. The user may then obtain a key for decrypting the encrypted content. Once the payment for the key has been completed, a key is provided from the clearing house to the user.<sup>3</sup>

Applicants Claim 23 recites that a payment system is provided for controlling the **continued use** of a software program by a user. The claimed terminal is configured to access software from a computer readable storage communicatively linked thereto. **The software is**

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<sup>2</sup> As discussed above, although all of the Applicants claims are listed, only Claim 23 has been properly rejected.

<sup>3</sup> See Downs at Figure 9.

**providing an interface** offering continued utilization of **the software** in exchange for payment from the user.

As Downs merely describes a methodology by which content is exchanged, it does not describe a system for continued use of a software program in which the software itself generates an interface offering continued utilization in exchange for payment.

Dependent Claims 24-35 recite additional features and functionality of the system which have yet to be examined by the Office. As independent Claims 36 and 37 recite substantially similar features to that discussed above, Applicants respectfully submit that these claims are likewise allowable over the cited reference.

Accordingly, Applicants respectfully request that the rejection of Claims 23-37 under 35 U.S.C. §102, be withdrawn.

CONCLUSION

**Applicants respectfully submit that the finality of the Office Action dated March 18, 2008, is premature and should be withdrawn.** Additionally, Applicants respectfully submit that the present application, including Claims 25-37, is in condition for allowance and such action is requested at an early date.

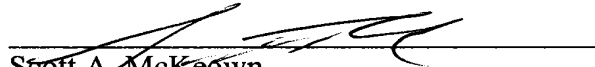
Respectfully submitted,

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